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**REMARKS**

Upon entry of this amendment, Claims 20-25 are pending in the present application and should stand rejected. Claims 1-19 have been withdrawn from consideration. Applicants believe that the Office has inadvertently stated, in the Office Action dated March 19, 2003, that Claim 20 has also been withdrawn. As shown by the Office Action dated August 8, 2002, Claim 20 is still pending in the application and should stand rejected since the remaining claims that are rejected depend from it. Claim 20 has been amended to provide further characteristics of the claimed invention. Basis for this amendment may be found in the specification, page 12, lines 32-36. It is believed that this change does not involve any introduction of new matter. No additional claim fees are believed to be due. Consequently, entry of this change is believed to be in order and is respectfully requested.

**INVENTION SYNOPSIS**

The present invention relates to a disposable absorbent article having a film-forming composition disposed on at least a skin-contacting surface of the absorbent article, wherein the composition is substantially anhydrous and is solid or semi-solid at room temperature. The composition comprises (a) from about 1 to about 80 wt% of a skin conditioning agent selected from the group consisting of petroleum based emollients; fatty acid esters; polysiloxanes; polyol polyesters; esters or ethers of polyhydroxy alcohols; fatty alcohol esters of polyprotic acids; animal oils, fats, and their derivatives; vegetable oils, hydrogenated vegetable oils, and their derivatives; branched hydrocarbons; fatty alcohol ethers; free sterols, sterol esters and their derivatives; sphingolipids; phospholipids; and mixtures thereof; (b) from about 15 to about 50 wt% of a viscosity enhancing agent selected from the group consisting of C12-C60 alcohols, waxes, fumed silicas, and mixtures thereof; (c) from about 1 to about 20 wt% of a film-forming agent selected from the group consisting of polyalkenes, PVP/alpha-olefin copolymers, acrylic copolymers, and mixtures thereof; and (d) optionally, from about 0.01 to about 10 wt% of a skin care ingredient selected from the group consisting of Monographed I actives, Monographed III actives, vitamins, proton donating agents, protease inhibitors, enzyme inhibitors, chelating agents, anti-microbials, skin soothing agents, and mixtures thereof; wherein the composition is resistant to water, wash-off, and rub-off.

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Applicants have found that the claimed composition forms a film that adheres to the skin. The film contains beneficial skin care ingredients and skin conditioning agents that are then held in intimate and prolonged contact with the skin such that they are able to provide benefit to the skin.

**REJECTION UNDER 35 USC § 103(a)**

Claims 20-25 should stand rejected under 35 USC § 103(a) as being unpatentable over Roe, et al. (US Patent 5,609,587) (hereafter "Roe") and further in view of Wenninger, et al. (*Int. Cos. Ingrid. Dict. And Hand. 1997*) (hereafter "Wenninger"). In support of this rejection, the Office reasons that Roe discloses the same composition components as claimed by Applicants. Applicants respectfully traverse this rejection.

Applicants submit that Claims 20-25 are not rendered obvious over Roe in view of Wenninger. First, Roe relates to a diaper containing a liquid pervious topsheet coated with a lotion composition. The lotion composition reduces the adherence of BM to the skin of the wearer, thereby improving the ease of BM cleanup, and improves skin softness. The lotion composition disclosed therein comprises a liquid polyol polyester and an immobilizing agent such as a fatty alcohol or paraffin wax to immobilize the liquid polyol polyester on the surface of the diaper topsheet. The polyol polyester(s) remain at or near the skin surface, providing the desired BM cleaning and/or therapeutic benefits. In particular, Roe discloses a diaper having a lotioned topsheet comprising a liquid polyol polyester emollient and an immobilizing agent. The disposable absorbent article can be sanitary napkins, panty-liners, diapers, incontinence briefs, etc. See, col. 4, lines 34-37. Roe also discloses that the lotion composition comprises (1) a liquid polyol polyester emollient; (2) an immobilizing agent(s) for the liquid polyol polyester emollient; (3) optionally, a hydrophilic surfactant; and (4) other optional components. See, col. 10, lines 38-42.

Applicants submit that the cited reference does not teach or suggest a composition which includes the specific film-forming agents that are claimed by the Applicants. Roe merely discloses a list of optional components that may be included in the composition. This list includes the generic listing of "film formers." See, col. 23, line 34. Roe, however, does not even define or exemplify "film formers" as requisite components in the disclosed composition as is

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clearly evidenced by the examples of the present application. The term "optional" teaches and suggests that a film former may compose 0 wt% of the composition. Applicants', however, claim from about 1 to about 20 wt% of a film forming agent present in the composition. In addition, the Roe patent does not teach or suggest the inclusion of a film-forming agent in its exemplary formulations. The Roe patent is directed merely towards a barrier against the contact of BM to the skin. Roe discloses a lotion composition that reduces the adherence of BM to the skin, thereby improving the ease of BM cleanup and enhancing skin softness. See, col. 1, lines 9-11. Applicants' invention, however, is an improvement on the Roe patent. Applicants' invention is directed towards providing an improved barrier to BM contact with the skin. The Applicants' invention has the added benefit of durability on the skin and is resistant to washing off and rubbing off. The present invention locks in the skin conditioning agents and active skin care ingredients of the lotion composition on the skin. This provides an improved barrier to the BM contact and adhesion of both the skin conditioning agents and active skin care ingredients to the skin. This is an improvement over Roe that would not have been obvious because this benefit is not taught or suggested as desirable by the Roe reference.

It is well known that most patents are granted on an improvement of a prior device. The improved device inherently achieves the same basic result as that achieved, and performs the same basic function as that performed, by the prior device. To require in every case that a new "function" or new "result" be performed or achieved would be destructive of "the progress of . . . useful arts" goal sought in the constitutional-statutory scheme. See Nikola v. Peterson, 580 F.2d 898 (6<sup>th</sup> Cir. 1978). To preclude patentability under 35 USC § 103, there must be some predictability of success in any attempt to combine elements of reference processes. The view that success would have been "inherent" cannot substitute for a showing of reasonable expectation of success. See In re Rinehart, 531 F.2d 1048 (C.C.P.A. 1976). "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." A retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See In re Rijckaert, 9 F.3d 1531 (Fed. Cir. 1993).

Claims 21-25 should therefore be deemed allowable as there is no basis for a finding of obviousness relative to Claim 20. This is the case since a dependent claim should be considered allowable when its parent claim is allowed. See In re McCann, 212 F.2d 797 (C.C.P.A. 1954).

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Summarily, the Roe reference fails to teach or suggest each and every limitation set forth in Applicants' invention. Therefore, it is respectfully submitted that rejection of Applicants' claims 20-25 as obvious over Roe is improper. Consequently, these rejections should be withdrawn.

The Office also contends that Claim 20 is unpatentable over Roe in view of Wenninger. The Office states that it would have been obvious to one skilled in the art at the time the invention was made to use the acrylates copolymers and polyethylene of Wenninger in the invention of Roe. The Office further states it is obvious to combine these references in light of Roe, at column 23, lines 41-44 which reads "all of these materials are well known in the art as additives for such formulations and can be employed in appropriate amounts in the lotion compositions of the present invention." Applicants respectfully traverse this rejection.

Wenninger is an excerpt from a cosmetic ingredient dictionary and handbook that discloses the use of acrylates copolymers as film formers and the use of polyethylene as a film-forming agent. Even though Wenninger discloses the use of these ingredients, it does not correct the deficiencies found in the Roe patent. While Wenninger may disclose the possible uses of various cosmetic ingredients, Wenninger does not teach or suggest the use of these ingredients in any particular amount or in any particular type of composition in combination with other ingredients as is currently claimed by Applicants.

It is well settled that the Office cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Applicants' invention. Rather, the Office has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See SmithKline Diagnostics, Inc. v. Helena Lab. Corp., 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1985). Here, there is no such teaching or suggesting. Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such as way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. In re Grabiak, 222 U.S.P.Q.2d 870, 872 (Fed. Cir. 1985). Furthermore, "obvious to try" is not a valid test of patentability. In re Dow Chemical Co., 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); In re Antoine, 195 U.S.P.Q. 6 (CCPA 1977). There must be a suggestion or teaching that the claimed novel form could or should be prepared. In re

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Cofer, 148 U.S.P.Q. 268 (CCPA 1966). Thus, it is clearly the case that the present invention could not have been rendered obvious by Roe or Wenninger since neither provide the limitations as set forth by the Applicants.

Summarily, the Wenninger reference fails to teach or suggest each and every limitation set forth in Applicants' invention. Therefore, it is respectfully submitted that rejection of Applicants' claims 20-25 as obvious over Roe in light of Wenninger is improper. Consequently, this rejection should be withdrawn.

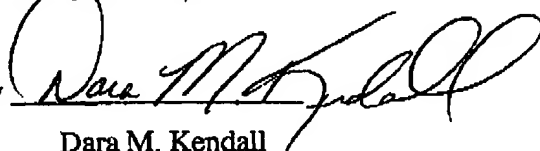
### CONCLUSION

Based on the foregoing reasons, Applicants respectfully submit that the Office has not made prima facie case of obviousness and the rejections are therefore improper. Reconsideration and withdrawal of the rejections is respectfully requested. Allowance of each of the pending claims in the next Office Action is earnestly requested.

Respectfully Submitted,

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By



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